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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,934	06/30/2000	Hiroshi Tanaka	0905-0239P-SP	8457
2292	7590	10/13/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				TRAN, PABLO N
		ART UNIT		PAPER NUMBER
		2685		

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/606,934	Applicant(s) TANAKA, HIROSHI
	Examiner Pablo N Tran	Art Unit 2685

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 03 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) The period for reply expires 3 months from the mailing date of the final rejection.
 b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
 ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
 2. The proposed amendment(s) will not be entered because:
 (a) they raise new issues that would require further consideration and/or search (see NOTE below);
 (b) they raise the issue of new matter (see Note below);
 (c) they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. Applicant's reply has overcome the following rejection(s): _____.
 4. Newly proposed or amended claim(s) _____. would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 5. The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
 6. The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
 7. For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 7.

Claim(s) withdrawn from consideration: 15-30.

8. The drawing correction filed on _____. is a) approved or b) disapproved by the Examiner.

9. Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.

10. Other: _____.

PABLO N. TRAN
PRIMARY EXAMINER



Continuation of 5. does NOT place the application in condition for allowance because: The Applicant's stated that the examiner's withdrawal of claims 15-30 is improper. As stated in the examiner rejection on 11/17/03, "Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 15-30 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP 821.03. 2. The newly submitted claims 15-30 directed to inventions that is independent or distinct from the invention originally claimed for the following reasons: Invention I, claim 7, drawn to a portable telephone set communicate with a first image processor wherein having judging means to judge whetherer or not the data amount of the image data to be received is not more than the amount of data which can be stored; Invention II, claims 15-16, drawn to a method of controlling the operations of an image communication system comprising the steps of transmitting the prepared image list, displaying an image list, and accepting an image identification selected in the display list, transmitting the accept image identification, transmitting the image data, and transmitting the received image data to a transmission destination through a communication network; Invention III, claims 17-18, drawn to a method of controlling the operations in a server and an image communication system comprising the steps of transmitting the kept image list or thumb-nail image list from said server to said portable telephone, displaying an image list or the thumb-nail image list, and accepting an image identification selected in the display image list or thumb-nail list, transmitting the accept image identification, transmitting the image data and transmitting the received image data to the image processor; Invention IV, claims 19-21, drawn to a portable telephone set capable of establishing data communication with an image processor comprising list command means, list receiving means, selection means, image request means, and image transmitting means; Invention V, claims 22-24, drawn to a portable telephone set capable of establishing data communication with a server comprising list command means, list receiving means, selection means, image request means, and image transmitting means; Invention VI, claims 25-28, drawn to a digital camera capable of establishing data communication with a MS comprising list creation means, list transmitting means, and image transmitting means; Invention VII, claim 29, drawn to a digital camera capable of establishing data communication with a portable telephone comprising list creation means, receiving means, and image transmitting means; Invention VIII, claim 30, drawn to a portable telephone set capable of establishing data communication with an image processor comprising command means, first receiving means, a display device, selection means, image request means, second receiving means, and image transmitting means. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group II has separate utility such as a method of controlling the operations of an image communication system comprising the steps of transmitting the prepared image list, displaying an image list, and accepting an image identification selected in the display list, transmitting the accept image identification, transmitting the image data, and transmitting the received image data to a transmission destination through a communication network. See MPEP § 806.05(d). Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group III has separate utility such as a method of controlling the operation in a server and an image communication system comprising the steps of transmitting the kept image list or thumb-nail image list from said server to said portable telephone, displaying an image list or the thumb-nail image list, and accepting an image identification selected in the display image list or thumb-nail list, transmitting the accept image identification, transmitting the image data, and transmitting the received image data to the image processor. See MPEP § 806.05(d). Inventions I and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group IV has separate utility such as a portable telephone set capable of establishing data communication with an image processor comprising list command means, list receiving means, selection means, image request means, and image transmitting means. See MPEP § 806.05(d). Inventions I and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group V has separate utility such as a portable telephone set capable of establishing data communication with a server comprising list command means, list receiving means, selection means, image request means, and image transmitting means. See MPEP § 806.05(d). Inventions I and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group VI has separate utility such as a digital camera capable of establishing data communication with a MS comprising list creation means, list transmitting means, and image transmitting means. See MPEP § 806.05(d). Inventions I and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group VII has separate utility such as a digital camera capable of establishing data communication with a portable telephone comprising list creation means, receiving means, and image transmitting means. See MPEP § 806.05(d). Inventions I and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group VIII has separate utility such as a portable telephone set capable of establishing data communication with an image processor comprising command means, first receiving means, a display device, selection means, image request means, second receiving means, and image transmitting means. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and have acquired separate status in the art because of their recognized divergent subject matters, and different searches are required for each groups. Therefore, the withdrawal of claims 15-30 are proper. Furthermore, Applicant stated that the combination of Niwa reference is not applicable. Niwa suggests such determination module to compare if there is enough free space to store image data and if there is sufficient free space-the image data will be stored in the storage module (col. 2/ln. 52-58). Therefore, the combination of Niwa reference is proper.